

### Remarks

This Amendment accompanies a Request for Continued Examination (RCE). Applicants request reconsideration of the rejections in the final Office Action and withdrawal of the same in view of the foregoing amendments and comments set forth below.

By this Amendment, claim 23 is amended. In particular, claim 23 recites that the assembly station includes a pocket and that the universal pickup and application device “conveys the coupon to a release position where the coupon is placed in a desired position relative to the pocket of the assembly station prior to insertion of the coupon into a packet.” Accordingly, claims 23-30 are pending in the present application.

Claims 23 and 25 were rejected under 35 U.S.C. §102(b) as being anticipated U.S. Patent No. 5,024,348 to Kronseder as explained in paragraph 2 of the Action. In view of the foregoing amendments to claim 23, it is believed that this rejection is now rendered moot.

Applicants’ claimed unit for applying printed coupons to packets in packaging machine includes 1(a) first means by which to feed coupons procured as single items ordered in a stack, or 1(b) second means by which to feed coupons obtained as cuts from a continuous strip; 2) an assembly station having a pocket; and 3) a universal pickup and application device. As recited in claim 23, the universal pickup and application device is installed permanently in the machine and can remove an individual coupon with equal facility from either the first or the second feed means at a pickup station and conveys the coupon to a release position where the coupon is placed in a desired position relative to

the pocket of the assembly station prior to insertion of the coupon into a packet. The coupon is then inserted into a partly finished cigarette pack (original claim 22).

Kronseder is directed to a magazine section for labels in a labeling machine. Kronseder discloses a main magazine 16 for supplying labels and a transfer plate for removing a label from a stationary stack of labels in magazine 16 (column 4, lines 26-29 of Kronseder). While the Action asserts that “The labels are subsequently applied to an article with the transport plate (47)”, the Applicants found no disclosure supporting this statement. Instead, Kronseder discloses that transfer plate 47 takes out the foremost label and is silent as to what transfer plate 47 does with the removed label (column 4, lines 26-29; column 6, lines 3-8; and column 7, lines 9-11 of Kronseder). Thus, Kronseder does not disclose the recited “universal pick up and application device which takes up an individual coupon ... and conveys the coupon to a release position where the coupon is placed in a desired position relative to the pocket of an assembly station” (claim 23, lines 6-9 of the present application).

Kronseder also fails to disclose the assembly station having a pocket, which receives the recited coupon. Thus, Kronseder cannot anticipate the claimed invention because it fails to disclose each and every recited feature of the claims. Accordingly, claims 23 and 25 are not anticipated by Kronseder and withdrawal of this rejection is respectfully requested.

Claim 23 was rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,812,195 to Vijuk as described in paragraph 3 of the Action. Applicants respectfully traverse this rejection.

Vijuk is directed to a method and apparatus for making outserts. In order to anticipate claim 23, Vijuk should disclose 1(a) first means by which to feed coupons procured as single items ordered in a stack, or 1(b) second means by which to feed coupons obtained as cuts from a continuous strip; 2) an assembly station having a pocket; and 3) a universal pickup and application device conveys the coupon to a release position where the coupon is placed in a desired position relative to the pocket of the assembly station prior to insertion of the coupon into a packet. The Action is silent as to the recited assembly station having a collar and a pocket; Applicants found no disclosure of the recited assembly station. Thus, Vijuk is at least missing element 2. In addition, Vijuk fails to disclose a universal pick up and application device that picks up a coupon and conveys the picked up coupon to the assembly station as recited in the claims.

Consequently, Vijuk cannot anticipate claim 23 as it at least fails to disclose elements 2 and 3. The Advisory Action did not mention how Vijuk could anticipate the claimed invention and Applicants cannot find elements 2 and 3, as argued above. Withdrawal of the rejection is respectfully requested.

Claims 23-28 were rejected under 35 U.S.C. §102(b) as being anticipated by EP 0 370 633 A1 to Bright as described in paragraph 4 of the Action. Applicants respectfully traverse this rejection.

Bright is directed to a convertible labeling machine. While Bright may disclose a receptacle 75 from which a label is extracted by vacuum and delivered to vacuum drum 31 or strip of label material that is severed to form a label and then moved via a vacuum drum 19, Bright does not disclose an assembly station having a pocket, as claim 23 now positively recites. Instead, Bright discloses a container feed 13 including a conveyor and

a star wheel 15 and implies that vacuum drum 19 applies the labels to the fed containers. This is not an assembly station having a collar and a pocket. Accordingly, Bright cannot anticipate claim 23 and its depending claims 24-30.

In addition, Bright fails to disclose the universal pickup and application device that is recited in claim 23. In particular, the universal pickup and application device conveys the coupon to a release position where the coupon is placed in a desired position relative to the collar at a pocket of the assembly station prior to insertion of the coupon into a packet. Bright simply discloses a container guide 17 and a curved pad 18 that hold containers against the vacuum drum 19 to wrap labels around the containers. The labels of Bright are not released or placed in a desired position relative to a pocket of the assembly station; but, are placed directly on the container. As discussed above, the coupons of Applicants' invention are placed in a position relative to the pocket of an assembly station and then, the coupon is conveyed between inner and outer envelopes of cigarette packets. That is, Bright fails to disclose, teach or suggest a universal pick up and application device that positions a coupon on an assembly station. Accordingly, Bright cannot anticipate the claimed invention.

The last five lines of claim 23 have been amended to recite a "wherein" clause. The Federal Circuit has held that language in "wherein" clauses should be considered and the single reference should at least be capable of performing the function set forth in the "wherein" clause. As argued above, Bright does not disclose an assembly station having a pocket and also discloses that the label is placed directly on the container and not placed in a desired position relative to the assembly station, as claimed. Thus, Bright only teaches a labeling device where a container receives the label directly from the vacuum

drum. Consequently, the device disclosed by Bright is not capable of conveying the label to a release position where the label is placed in a desired position relative to a portion of the assembly station. Withdrawal of the rejection under 35 U.S.C. §102(b) by Bright is respectfully requested.

Claim 29 and 30 were rejected under 35 U.S.C. §103(a) as being unpatentable over Bright in view of U.S. Patent Nos. 5,203,953 to Focke et al. and 4,605,459 to Voltmer et al. This rejection is respectfully traversed.

Focke et al. at least fail to disclose elements 2) and 3) argued above. In particular, Focke et al disclose labels 10 are held on the periphery of label drum 13 by mechanic and pneumatic means until they are transferred to the pack 11 (column 2, lines 61-63 of Focke et al). This is similar to the disclosure of Bright where the label goes from the vacuum drum 19 to the container. Thus, Focke also fails to disclose, teach or suggest conveying the label to a release position where the label is placed in a desired position relative to a portion of the assembly station, prior to attaching the label to the workpiece.

Focke et al. discloses a conveyor 12 upon which packs 11 are moved. This is not an assembly station having a collar and a pocket. Nowhere does Focke et al. disclose, teach or suggest an assembly station and releasing a label relative to a pocket of the assembly station, as required by claim 23. Accordingly, Focke et al. cannot provide motivation to modify Bright, as Focke et al. disclose a label operation that goes from the initial feeder directly to the workpiece, which is the same as the invention disclosed by Bright.

Voltmer et al. were applied for their disclosure of suction bores or cups. Like Bright and Focke et al, Voltmer et al. disclose a system for directly applying literature to

a container (workpiece). Accordingly, Voltmer et al. cannot cure the defects of Bright or Focke et al., and Voltmer et al. cannot render the claimed invention unpatentable.

Withdrawal of this rejection under 35 U.S.C. §103(a) is requested.

It is respectfully submitted that this Amendment places the application in condition for allowance by positively reciting the features indicated in the Advisory Action as not being claimed.


A request for the necessary extension for filing this response the response in the third month (the first and second months being requested and charged with the May 3, 2005 Amendment) is attached, as well as authorization to charge our Deposit Account No. 22-0261 for payment of the applicable extension fee.

In view of the foregoing, it is respectfully submitted that claims 23-30 are allowable over the prior art of record. Reconsideration of the application, withdrawal of the rejections of record and an issuance of a Notice of Allowance are earnestly solicited.

If the Examiner is of the opinion that the prosecution of the application would be advanced by a personal interview, the Examiner is invited to telephone undersigned counsel to arrange for such an interview.

Respectfully submitted,

Date: June 7, 2005

  
Catherine M. Voorhees  
Registration No. 33,074  
VENABLE LLP  
P.O. Box 34385  
Washington, D.C. 20043-9998  
Telephone: (202) 344-4000  
Telefax: (202) 344-8300

CMV/elw  
DC2/655099